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Paper 24

Filed by: Trial Section Merits Panel  
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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DWIGHT T. TOMES,  
ARTHUR WEISSINGER, JOHN C. SANFORD,  
and THEODORE M. KLEIN,

Junior Party,  
(Application 08/442,522),

v.

GLETA CARSWELL,  
YIN-FU CHANG, MARY DELL-CHILTON,  
and CHRISTIAN HARMS

Senior Party,  
(Application 08/447,057).

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Patent Interference No. 104,453

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Before McKELVEY, Senior Administrative Patent Judge, and LEE  
and GARDNER-LANE, Administrative Patent Judges.

GARDNER-LANE, Administrative Patent Judge.

**JUDGMENT PURSUANT TO 37 CFR § 1.662**

Tomes has filed a paper entitled "ABANDONMENT OF CONTEST

FOR COUNT 2 BY TOMES" (Paper 23). In the paper, Tomes states "Tomes hereby abandons the contest with respect to Count 2 to insect resistant transgenic corn in Interference Nos. 104,453 and 104,513 by hereby canceling claims 41, 66 and 81 in U.S. Serial No. 08/442,522, the only Tomes claims which correspond to Count 2."

Carswell has filed a paper entitled "CARSWELL ABANDONMENT OF CONTEST AND CONCESSION OF UNPATENTABILITY UNDER 37 C.F.R. § 1.662" (Paper 20). In the paper, Carwell states that it "hereby abandons the contest as to Count 1 in the present interference and concedes that the subject matter of Count 2 is not patentable to either party in the interference." Carswell states that it is expressly abandoning its involved 08/447,057 application.

When a party either (1) concedes unpatentability of the subject matter of a count or (2) abandons the contest as to a count, the concession or abandonment is treated as a request for entry of an adverse judgment against the party as to all the claims that correspond to the count. 37 CFR § 1.662(a). Accordingly, (1) the statement by Tomes (Paper 23) is treated as a request for adverse judgment as to count 2, and (2) the statement by Carswell (Paper 20) is treated as a request for

adverse judgment as to both counts 1 and 2.

Claims of an involved application may be amended during the interference only if a preliminary motion under 37 CFR § 1.633(c) is granted. Since Tomes did not file a preliminary motion under § 1.633(c) to amend its claims and accordingly, no such preliminary motion was granted, it would be inappropriate to cancel Tomes claims 41, 66 and 81 at this time.

Upon consideration of the record of the interference, it is

ORDERED that judgment on priority as to Count 1, is awarded against senior party GLETA CARSWELL, YIN-FU CHANG, MARY DELL-CHILTON, and CHRISTIAN HARMS;

FURTHER ORDERED that senior party GLETA CARSWELL, YIN-FU CHANG, MARY DELL-CHILTON, and CHRISTIAN HARMS, is not entitled to a patent containing claims 112-114, 119-125, and 132 of application 08/447,057 which correspond to Count 1;

FURTHER ORDERED that judgment on priority as to Count 2, is awarded against junior party DWIGHT T. TOMES, ARTHUR WEISSINGER, JOHN C. SANFORD, and THEODORE M. KLEIN and senior party GLETA CARSWELL, YIN-FU CHANG, MARY DELL-CHILTON, and CHRISTIAN HARMS;

FURTHER ORDERED that junior party DWIGHT T. TOMES,

ARTHUR WEISSINGER, JOHN C. SANFORD, and THEODORE M. KLEIN is not entitled to a patent containing claims 41, 66, and 81, of application 08/442,522 which correspond to Count 2;

FURTHER ORDERED that senior party GLETA CARSWELL, YIN-FU CHANG, MARY DELL-CHILTON, and CHRISTIAN HARMS, is not entitled to a patent containing claims 118 and 126-131, of application 08/447,057 which correspond to Count 2;

FURTHER ORDERED that a copy of this decision be given a paper number and be entered in the administrative records of Tmes 08/442,522 application and Carswell's 08/447,057 application.

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FRED McKELVEY, Senior	)	
Administrative Patent Judge	)	
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	)	
_____	)	BOARD OF PATENT
JAMESON LEE	)	APPEALS AND
Administrative Patent Judge	)	INTERFERENCES
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SALLY GARDNER-LANE	)	
Administrative Patent Judge	)	

cc (via facsimile and first class mail):

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